

Application No. 10/767675
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Amendment
Attorney Docket No. S63.2B-10813-US01

Amendments To The Drawings:

The attached three sheets of drawings include changes to Figures 1 and 2, and new Figure 13. The first sheet includes amended Figure 1 and replaces the original drawing sheet that included the previous version of Figure 1. The second sheet includes amended Figure 2 and replaces the original drawing sheet that included the previous version of Figure 2. The third sheet includes Figure 13, and is a new sheet. The specific changes to the drawings are discussed in the Remarks section of this Amendment.

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Remarks

This Amendment is in response to the Office Action dated **January 4, 2007**. Claims 1-57 are pending in this application. Claims 27-57 have been withdrawn from consideration. The Office Action rejected claims 1-3, 5, 6 and 14-17 under 35 USC § 102 over Follmer (US 5728065); rejected claim 4 under 35 USC § 103 over Follmer in view of Jacobsen (US 20030069522); rejected claims 7-11 under 35 USC § 103 over Follmer in view of Ellis (US 6395008); rejected claims 12 and 13 under 35 USC § 103 over Follmer in view of Ressemann (US 5921958); rejected claim 18 under 35 USC § 103 over Follmer in view of Gambale (US 6447522); rejected claims 19 and 20 under 35 USC § 103 over Follmer in view of Cathcart (US 5951585); rejected claims 21-24 under 35 USC § 103 over Follmer in view of Imran (US 5766203); rejected claims 25 and 26 under 35 USC § 103 over Follmer in view of Feingold (US 6162229); and objected to the drawings.

By this Amendment, claims 1, 2, 6, 7, 16 and 25 are amended and withdrawn claims 27-57 are cancelled without prejudice or disclaimer. Applicants reserve the right to prosecute all cancelled subject matter in a subsequent patent application claiming priority to the immediate application. Support for the amendments can be found at least in the specification at page 9, lines 7-15; page 11, lines 6-10; and page 12, lines 6-9; and in Figure 2. The specification and the drawings are amended to obviate the Office Action's objections. Figure 13 has also been added. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

Title

Applicants have noted a potential error in the title of the application. The correct title is "Catheter Tip." However, the title is misspelled as "Catherter Tip" in some USPTO documents. For example, the published application – US 2005/0171591 – includes the misspelled title. A printout from the Patent Application Information Retrieval (PAIR) system attached to this Amendment also includes the error. Applicants request that the Examiner correct the problem, or alternatively provide guidance as to which USPTO department the Applicants should contact.

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Drawings and Specification

The Office Action objects to the drawings for not including reference characters 38 and 42, which are mentioned in the specification, and for including reference character 18, which was not included in the specification.

Amended Figures 1 and 2 are submitted herewith. Reference character 38 is added to Figures 1 and 2, and reference character 42 is added to Figure 2.

The specification is also amended to refer to the lumen 18 that extends through the catheter shaft 12. A person of ordinary skill in the art would recognize that reference character 18 identifies a lumen in Figures 2 and 3 as filed. Therefore, the addition to the specification does not comprise new matter. The amendments are believed to obviate the objections. Accordingly, Applicants request withdrawal of the objection to the drawings.

Figure 13

New Figure 13 is also added by this Amendment. This Figure was inadvertently omitted from the original application.

Applicants previously attempted to add Figure 13 in the preliminary amendment filed February 20, 2004, wherein the application was given a new filing date because Figure 13 was treated as new matter. Applicants believe that Figure 13 is fully supported by the original application, and subsequently filed a request to correct the filing date. In the Petitions Decision mailed April 14, 2005, the filing date was reset to January 29, 2004 and it was indicated that Figure 13 would not be entered. In a subsequent teleconference with Applicants' undersigned representative, the petitions attorney advised that Figure 13 should be added by amendment before the Examiner.

Figure 13 is fully supported by the specification as originally filed (see page 5, lines 11 – 12 and page 12, line 21 – page 13, line 2). Each part of the structure shown in Figure 13 is shown in other Figures of the application (for example, see Figure 2). Figure 13 contains only two reference numerals not shown in the other Figures, namely reference numerals 66 (first free end) and 68 (second free end). Description of the first free end 66 and second free end 68 may be found in the specification at page 12, lines 23 – 24.

Applicants request that if the Examiner believes any part of Figure 13 would be

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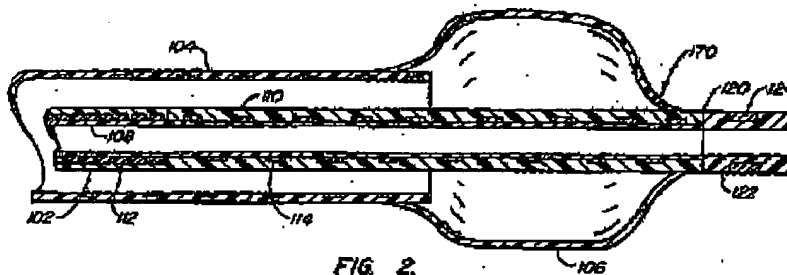
new matter, the Examiner contact Applicants' undersigned representative to discuss the issue.

Claim Rejections – Independent Claim 1

The Office Action rejected claims 1-3, 5, 6 and 14-17 under 35 USC § 102 over Follmer. The Office Action also rejected, under 35 USC § 103, various dependent claims over Follmer combined with other references as listed in the first paragraph of the Remarks section on page 7.

Claim 1 has been amended and requires a “recessed portion” to be “oriented beneath the balloon distal cone portion.” As described in the application at page 9, lines 13-15, such a recessed portion allows for storage of the balloon cone and provides for a lower profile catheter assembly.

In rejecting claim 6, which previously included the “recessed portion” limitation now included in claim 1, the Office Action cited to Follmer Figure 2, and seemed to assert that the “recessed portion” limitation was met by the area occupied by marker ring 124. See Office Action at page 3, paragraph #7. Follmer Figure 2 is provided below.



From Figure 2, it is clear that the area occupied by the marker ring 124 does not comprise a recess that is “oriented beneath the balloon distal cone portion” as required by claim 1. The area occupied by the marker ring 124 is offset from the balloon along the length of the catheter.

Follmer does not disclose or suggest a recess oriented beneath the balloon distal cone portion. Thus, Follmer does not disclose or suggest all of the limitations of independent claim 1. Therefore, Applicants assert that claim 1 is patentable over Follmer under 35 USC § 102. Claims 2, 3, 5, 6, 14, 15 and 17 depend from claim 1 and are patentable over Follmer for at least the reasons discussed with respect to claim 1. Accordingly, Applicants request withdrawal

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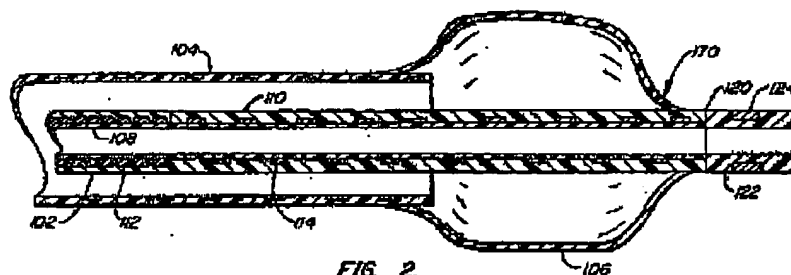
of the rejections under 35 USC § 102.

The rejections under 35 USC § 103 are traversed, however, claim 1 has been amended for the purpose of furthering prosecution. The amendment is believed to render the rejections under 35 USC § 103 moot. The references applied under 35 USC § 103 do not provide a teaching that would motivate a person of ordinary skill in the art to modify Follmer in a way that would create a recess oriented beneath the balloon distal cone, as required by claim 1. The dependent claims rejected under 35 USC § 103 are patentable over the applied references for at least the reasons discussed with respect to claim 1. Accordingly, Applicants request withdrawal of the rejections under 35 USC § 103.

Claim Rejections – Independent Claim 16

The Office Action rejected previously dependent claim 16 under 35 USC § 102 over Follmer. Claim 16 has been rewritten in independent form and amended to specify that the “entrained stiffening fibers” are “selected from a group consisting of carbon fibers, polypropylene fibers and polyolefin fibers.”

The Office Action asserts that the reinforcement ribbon 114 of Follmer meets the limitation of “entrained stiffening fibers.” See Office Action at page 4, paragraph #9 and Follmer Figure 2, provided below. Follmer teaches that the reinforcement 114 will usually be a stainless steel ribbon. See column 7, lines 10-13.



Follmer does not disclose or suggest any of the specific types of fibers recited in the claim, namely carbon fibers, polypropylene fibers or polyolefin fibers. Further, a person of ordinary skill in the art would understand “entrained stiffening fibers” to mean something other than a “stainless steel ribbon” as taught by Follmer. Additionally, the rejected claim recites “fibers” in plural, and the single reinforcing ribbon 114 of Follmer does not meet the plural

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requirement.

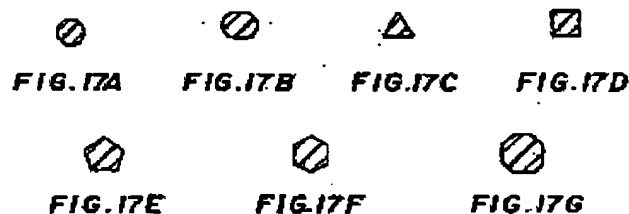
Therefore, Applicants assert that Follmer does not disclose or suggest all of the limitations recited in claim 16, and that claim 16 is patentable over Follmer under 35 USC § 102. Accordingly, Applicants request withdrawal of the rejection of claim 16.

Claim Rejections – Independent Claim 25

The Office Action rejects claims 25 and 26 under 35 USC § 103 over Follmer in view of Feingold. These rejections are traversed.

Claim 25 has been rewritten in independent form, and has further been amended to specify that the claimed “shaped portion” is “oriented beneath said balloon.”

Feingold teaches a device for injecting an intraocular lens that includes a deformable tip. Feingold teaches a number of possible cross-sectional shapes for the tip. See column 9, lines 40-57, and Figures 17A-17G, provided below.



Feingold does not discuss benefits of the various cross-sectional shapes, and further does not provide any motivation for choosing one particular shape over the others, except for a statement that in a most preferred embodiment, the cross-sectional shape of the tip is the same as the delivery passageway of the device. See column 7, lines 1-8.

The Office Action asserts that Feingold teaches that the triangular shape allows a smaller profile tip to be employed. Applicants are unable to find such a teaching in Feingold. Further, the Feingold tips are deformable, and therefore are less likely to damage an intraocular lens. See e.g. column 2, lines 47-58. Because the Feingold tips are readily deformable, the specific cross-sectional shape is not critical, as external loading will change the shape.

Even if Feingold did include the teachings asserted in the Office Action, it is unclear how the existence of a triangular tip in an intraocular lens injecting device would motivate a person to modify the Follmer balloon catheter. Further, claim 25 now requires the

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"shaped portion" to be oriented beneath the balloon. Feingold does not provide any motivation to modify Follmer in a way that would result in a device meeting the limitations of claim 25. Therefore, Applicants assert that independent claim 25 is patentable over Follmer in view of Feingold. Claim 26 depends from claim 25 and is patentable over Follmer in view of Feingold for at least the reasons discussed with respect to claim 25. Accordingly, Applicants request withdrawal of the rejections.

Conclusion

Based on at least the foregoing amendments and remarks, Applicants respectfully submit this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-26 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: April 4, 2007

By: _____

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